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| 09/996,899 | 11/30/2001 | Howard Taub | 10982142-1 | 3258 |

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| EXAMINER |
|---|
| MYHRE, JAMES W |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3622 | |

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | Application No. | Applicant(s) |
| --- | --- | --- |
| **Office Action Summary** | 09/996,899 | TAUB ET AL. |
| | Examiner | Art Unit |
| | James W. Myhre | 3622 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on <u>01 August 2005</u>.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-9 and 11-48* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9 and 11-48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

## DETAILED ACTION

### *Response to Amendment*

1.      The amendment filed on August 1, 2005 has been considered but is ineffective to overcome the Goldhaber et al (5,794,210) and Dedrick (5,768,521) references. The amendment canceled Claim 10 and amended Claims 1, 3, 4, 6-9, 11, 30, 40, and 46. The currently pending claims considered below are Claims 1-9 and 11-48.

### *Claim Objections*

2.      Claims 20 and 21 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claims 20 and 21 are written as being dependent upon Claim 13, a method claim. However, neither the printer of Claim 20 nor the computer of Claim 21 further limit the parent claim by changing, adding, or deleting any of the steps of the method. Therefore, they are considered as improper dependent claims. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

### *Claim Rejections - 35 USC § 103*

3.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4.      Claims 1-9, 11, 12, and 30-39 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Goldhaber et al (5,794,210) in view of Dedrick (5,768,521).

Claim 1: Goldhaber discloses an apparatus for presenting content packages to a

user, comprising:

a. a processor (col 9, lines 33-40);

b. a memory with a content package stored thereon (col 10, lines 39-63

and col 15, lines 26-28); and

c. the content package including a message, a bank id, and a display

value (col 10, lines 39-63).

The Examiner notes Claim 1 is directed towards a server with three parts: a

processor, a memory, and a content package (i.e. data) stored on the memory. Since

no action is being taken on the stored data, no patentable weight is given as to what the

data is or what type of data it is. However, notwithstanding that, Goldhaber does

disclose a server with the same type of data stored thereon. Furthermore, Dedrick also

discloses an apparatus for presenting content packages to a user that includes a

processor and a memory with a content package stored thereon that includes a plurality

of values arranged in a pricing hierarchy for advertising information for each advertising

message based on how well the user's profile matches the target user's profile (col 5,

lines 47-50). Therefore, it would have been obvious to one having ordinary skill in the

art at the time the invention was made to include a plurality of values with the content

package stored in Goldhaber.  One would have been motivated to have a plurality of

values associated with the same content package in order to charge the advertiser

based on the user's "worth" to the advertiser as in Dedrick.


Claim 2:  Goldhaber and Dedrick disclose the apparatus of Claim 1 above, but

Goldhaber does not explicitly disclose that the message has a message identifier (e.g.

name, number, code, etc.).  However, Dedrick discloses identifying the message in the

content package with a unique identifier (col 3, lines 39-45).  Therefore, it would have

been obvious to one having ordinary skill in the art at the time the invention was made

to also uniquely identify the message in Goldhaber.  One would have been motivated to

include a message identifier in order to allow Goldhaber to correlate the message with

the correct content provider when determining which content provider account to debit.


Claims 3 and 4:  Goldhaber and Dedrick disclose the apparatus of Claim 1

above, and Goldhaber further discloses paying the display value to the user upon the

message (advertisement) being displayed to or interacted upon by the user.  However,

it is not explicitly disclosed that the user could receive additional payments for both

displaying and interacting with the message, such as printing or playing the message.

The Examiner notes that the disclosed interacting with the message by the user would

encompass all types of interactions to include viewing, clicking on, printing, playing,

listening to, or downloading and storing the message.  These are all well known types of

interactions between a user and information being displayed on the user's computer. It is also well known for an advertiser to pay a first amount when a user is initially displayed an advertisement, and then pay a second amount if the user interacts with the advertisement in one of the above mentioned ways. For example, two well known methods for charging advertisers on the Internet are the pay-per-view and the pay-per-click-through methods. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to transfer a first value to the user in Goldhaber upon initially displaying the advertisement and then a second value when the user interacts therewith, such as printing or playing the advertisement. One would have been motivated to pay an additional value to the user in view of Goldhaber's goals of enticing the user to accept advertisements and of tracking the user's interactions therewith.

Claim 5: Goldhaber and Dedrick disclose the apparatus of Claim 1 above, and Goldhaber further discloses digitally signing the content package (col 10, lines 9-38 and col 16, lines 50-64).

Claim 6: Goldhaber and Dedrick disclose the apparatus of Claim 1 above, and Goldhaber further discloses instructions for receiving one of the values (col 11, lines 45-58).

Claims 7-9: <u>Goldhaber</u> and <u>Dedrick</u> disclose the apparatus of Claim 1 above,
and <u>Goldhaber</u> further discloses that at least one of the values is monetary, a credit on
a purchase, or a credit slip (i.e. coupon)(col 11, lines 8-44 and col 18, lines 13-33).

Claims 11 and 12: <u>Goldhaber</u> and <u>Dedrick</u> disclose the apparatus of Claim 1
above, and <u>Goldhaber</u> further discloses receiving notice of receipt or recall (deletion) of
the package (col 5, line 54 – col 6, line 2 and col 17, lines 49-52).

Claim 30: <u>Goldhaber</u> discloses a method for presenting content packages to a
user, comprising:

a. Constructing and delivering a content package consisting of a message and a
rendering value (col 9, lines 62-67);

b. Receiving notification of receipt of the content package (col 5, line 54 – col 6,
line 2); and

c. Crediting the value to the receiver (user)(col 16, lines 13-17).

While <u>Goldhaber</u> does not explicitly disclose that the rendering value is
one of a plurality of rendering values associated with the content package, <u>Dedrick</u> also
discloses a method for presenting content packages to a user that includes constructing
and storing a content package stored thereon that includes a plurality of values
arranged in a pricing hierarchy for advertising information for each advertising message
based on how well the user's profile matches the target user's profile (col 5, lines 47-
50). Therefore, it would have been obvious to one having ordinary skill in the art at the

time the invention was made to include a plurality of values with the content package

stored in Goldhaber.  One would have been motivated to have a plurality of values

associated with the same content package in order to charge the advertiser based on

the user's "worth" to the advertiser as in Dedrick.


Claim 31:  Goldhaber and Dedrick disclose the method and apparatus of Claim

30 above, but Goldhaber does not explicitly disclose that the message has a message

identifier (e.g. name, number, code, etc.).  However, Dedrick discloses identifying the

message in the content package with a unique identifier (col 3, lines 39-45).  Therefore,

it would have been obvious to one having ordinary skill in the art at the time the

invention was made to also uniquely identify the message in Goldhaber.  One would

have been motivated to include a message identifier in order to allow Goldhaber to

correlate the message with the correct content provider when determining which content

provider account to debit.


Claims 32 and 33:  Goldhaber and Dedrick disclose the method program as in

Claim 30 above, and Goldhaber further discloses providing the bank id (and account

number) of the receiver (user)(col 16, line 13-17).


Claim 34:  Goldhaber and Dedrick disclose the method as in Claim 30 above,

and Goldhaber further discloses the message is displayed to or interacted upon by the

user.  However, it is not explicitly disclosed that the user interaction includes printing or

playing the message. The Examiner notes that the disclosed interacting with the
message by the user would encompass all types of interactions to include viewing,
clicking on, printing, playing, listening to, or downloading and storing the message.
These are all well known types of input/output interactions between a user and
information being displayed on the user's computer (e.g. Dedrick, col 1, lines 30-32).
Therefore, it would have been obvious to one having ordinary skill in the art at the time
the invention was made to allow the user to print or play the message. One would have
been motivated to include printing or playing the message as part of Goldhaber's
interactions in order to provide a more memorable experience for the user; thus,
increasing the likelihood that the user will remember the message (advertisement) and,
in case of message being in the form of a coupon as Goldhaber discloses, providing a
hard copy of the coupon for the customary in-store redemption.


Claim 35: Goldhaber and Dedrick disclose the method as in Claim 30 above,
and Goldhaber further discloses the message is an advertisement (col 9, lines 62-67
and col 15, lines 25-27).


Claim 36: Goldhaber and Dedrick disclose the method as in Claim 30 above,
and Goldhaber further discloses verifying the bank account id and the funds therein (col
7, lines 48-61).

Claim 37:  Goldhaber and Dedrick disclose the method as in Claim 30 above,

and Goldhaber further discloses instructions for receiving the value (col 11, lines 45-58).

Claim 38:  Goldhaber  and Dedrick disclose the method as in Claim 30 above,

and Goldhaber further discloses paying the display value to the user upon the message

(advertisement) being displayed to or interacted upon by the user.  However, it is not

explicitly disclosed that the user could receive additional payments for both displaying

and interacting with the message, such as printing or playing the message.  The

Examiner notes that the disclosed interacting with the message by the user would

encompass all types of interactions to include viewing, clicking on, printing, playing,

listening to, or downloading and storing the message.  These are all well known types of

interactions between a user and information being displayed on the user's computer

(e.g. Dedrick, col 1, lines 30-32).  It is also well known for an advertiser to pay a first

amount when a user is initially displayed an advertisement, and then pay a second

amount if the user interacts with the advertisement in one of the above mentioned ways.

For example, two well known methods for charging advertisers on the Internet are the

pay-per-view and the pay-per-click-through methods.  Therefore, it would have been

obvious to one having ordinary skill in the art at the time the invention was made to

transfer a first value to the user in Goldhaber upon initially displaying the advertisement

and then a second value when the user interacts therewith, such as printing or playing

the advertisement.  One would have been motivated to pay an additional value to the

user in view of <u>Goldhaber</u>'s goals of enticing the user to accept advertisements and of

tracking the user's interactions therewith.


Claim 39: <u>Goldhaber</u> and <u>Dedrick</u> disclose the method of Claim 30 above, and

<u>Goldhaber</u> further discloses digitally signing the content package (col 10, lines 9-38 and

col 16, lines 50-64).


5.      Claims 13-29 and 40-48 are rejected under 35 U.S.C. 103(a) as being

unpatentable over <u>Goldhaber et al</u> (5,794,210).

Claims 13, 22, 24, 40, 43, and 45: <u>Goldhaber</u> discloses a method, apparatus,

and computer program for presenting content packages to a user, comprising:

      a. Providing a computer processor (col 9, lines 33-40);

      b. Storing a content package in memory (col 10, lines 39-63 and col 15,

lines 26-28);

      c. The content package including a message, bank id, and display value

(col 10, lines 39-63);

      d. Instructions for receiving the value (col 11, lines 45-58);

      e. Verifying the bank account id and the funds therein (col 7, lines 48-61);

      f. Receiving notice of receipt of the package (col 5, line 54 – col 6, line 2);

and

      g. Crediting the value to the receiver (user)(col 16, lines 13-17)

While Goldhaber does not explicitly disclose that the user will preset a desired value level for the display value and that the computer program will only display messages with values which meet or exceed that level, it is disclosed that the user presets a number of criteria for the selection of which messages will be selected and displayed when the user is registering with the system. It is also inherent that only a limited number of messages from which to select may be displayed on the user's screen at one time. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allow the user to also set a minimum limit on the value of the message the user is willing to accept. One would have been motivated to have the user in Goldhaber set such a minimum value level in order to increase the worth of Goldhaber's invention to the user by eliminating low value messages, thus presenting only the highest valued messages on the user's screen to increase the user's satisfaction with the system.

Claims 14, 18, and 42: Goldhaber discloses the method and computer program of Claims 13 and 40 above, and further discloses paying the display value to the user upon the message (advertisement) being displayed to or interacted upon by the user. However, it is not explicitly disclosed that the user could receive additional payments for both displaying and interacting with the message, such as printing or playing the message. The Examiner notes that the disclosed interacting with the message by the user would encompass all types of interactions to include viewing, clicking on, printing, playing, listening to, or downloading and storing the message. These are all well known

types of interactions between a user and information being displayed on the user's

computer. It is also well known for an advertiser to pay a first amount when a user is

initially displayed an advertisement, and then pay a second amount if the user interacts

with the advertisement in one of the above mentioned ways. For example, two well

known methods for charging advertisers on the Internet are the pay-per-view and the

pay-per-click-through methods. Therefore, it would have been obvious to one having

ordinary skill in the art at the time the invention was made to transfer a first value to the

user in Goldhaber upon initially displaying the advertisement and then a second value

when the user interacts therewith, such as printing or playing the advertisement. One

would have been motivated to pay an additional value to the user in view of Goldhaber's

goals of enticing the user to accept advertisements and of tracking the user's

interactions therewith.


Claims 15, 25, 26, 47, and 48: Goldhaber discloses the apparatus, method, and

computer program as in Claims 13, 22, and 40 above, and further discloses sending a

notification upon completion of the funds transfer (col 17, lines 44-63).


Claims 16, 17 and 46: Goldhaber discloses the method and computer program

as in Claims 13 and 40 above, and further discloses the message is displayed to or

interacted upon by the user. However, it is not explicitly disclosed that the user

interaction includes printing or playing the message. The Examiner notes that the

disclosed interacting with the message by the user would encompass all types of

interactions to include viewing, clicking on, printing, playing, listening to, or downloading

and storing the message. These are all well known types of input/output interactions

between a user and information being displayed on the user's computer (e.g. Dedrick,

col 1, lines 30-32). Therefore, it would have been obvious to one having ordinary skill in

the art at the time the invention was made to allow the user to print or play the

message. One would have been motivated to include printing or playing the message

as part of Goldhaber's interactions in order to provide a more memorable experience for

the user; thus, increasing the likelihood that the user will remember the message

(advertisement) and, in case of message being in the form of a coupon as Goldhaber

discloses, providing a hard copy of the coupon for the customary in-store redemption.


Claim 19: Goldhaber discloses the coupon program as in Claim 13 above, and

further discloses providing the bank id (and account number) of the receiver (user)(col

16, line 13-17).


Claims 20 and 21: Goldhaber discloses the coupon program as in Claim 13

above, and further discloses the computer program running on various user devices to

include a personal computer. While it is not explicitly disclosed that the computer

program is running on a printer, it would have been obvious to one having ordinary skill

in the art at the time the invention was made that the user device could include a printer,

if the printer had the required computing capability, or if a computer has a built-in

printing capability, such as the Wang™ word processors of the 1980's. The Examiner

notes that the line between a computer with printing capabilities and a printer with computing capabilities is very fine and is quickly becoming non-existent with the emergence of multiple-use devices. Thus, Goldhaber's disclosure of various types of user devices would also encompass a printer with the necessary processing and memory capabilities or a computer with the necessary printing capabilities.

Claim 23: Goldhaber discloses the apparatus as in Claim 22 above, and further discloses deleting the message if the value is too low (col 18, lines 49-50 and col 19, lines 4-18). Goldhaber discloses the system deactivating the advertisement once the user has accessed (and received payment for) it and also the user deleting the message when it is no longer desired. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for the system to delete messages that did not meet the user's criteria from the list of messages selected for delivery to the user. One would have been motivated to delete the messages that did not meet the user's minimum value level, in order to present only those messages that meet all of the user's selection criteria.

Claims 27-29: Goldhaber discloses the apparatus as in Claim 22 above, and further discloses that the value is monetary, a credit on a purchase, or a credit clip (i.e. coupon)(col 11, lines 8-44 and col 18, lines 13-33).

Claim 41: <u>Goldhaber</u> discloses the method as in Claim 40 above, and further

discloses the message is an advertisement (col 9, lines 62-67 and col 15, lines 25-27).

Claim 44: <u>Goldhaber</u> discloses the method of Claim 40 above, and further

discloses digitally signing the content package (col 10, lines 9-38 and col 16, lines 50-

64).

## *Response to Arguments*

6.       Applicant's arguments filed August 1, 2005 have been fully considered but they

are not persuasive.

a. The Applicant arguments against the 35 U.S.C. 102 rejection of Claims 1, 5-

12, 30, 35-37, and 39 are moot since this rejection is no longer being applied against

these claims.  The newly added limitation of "a plurality of values" has necessitated the

change to a rejection under 35 U.S.C. 103 above.

b. The Applicant argues in reference to Claim 13 that <u>Goldhaber</u> does not

disclose "a bank request module configured to verify that an advertiser bank account ...

can satisfy the value identified in the content packet" (page 17).  In other words, a

mechanism for verifying that the bank account has sufficient funds to complete the

transaction.  The Examiner notes that <u>Goldhaber</u> discloses a financial clearinghouse

that is "responsible for assuring that consumers pay for some information content

delivered to them and are compensated for paying attention to other information content

delivered to them" (col 10, lines 1-8).  It is inherent that for the financial clearinghouse to

assure that the consumer are compensated the advertiser bank account must be checked for sufficient funds. Non-existent funds cannot be transferred. The argument in reference to the rendering module and the preset value has been further addressed in the rejection above.

c. The Applicant argues in reference to Claim 22 that Goldhaber does not disclose a printer that verifies that the message was printed and notifies the sender or that "criteria entered by the user has anything to do with the value a recipient can receive" (page 18). The Examiner notes that Goldhaber discloses targeting the advertisements to users who meet the advertiser's targeting criteria and also discloses that the advertiser's could bid on the opportunity to present an advertisement to a user. Thus, it would have been obvious for the advertiser to place (and pay) a higher value on a user who matches more of the targeting criteria than a user who matches less of the criteria. Goldhaber also discloses various means to assure that the user actually viewed or interacted with the advertisement and for sending reports with the tracked information to the advertiser, i.e. notify the sender that the message was received and interacted with (e.g. printed).

d. The Applicant presents the same arguments in reference to Claim 40 as to Claim 22 above. The same response applies.

e. The Applicant argues in reference to Claims 2 and 31 that Dedrick does not overcome the deficiencies of Goldhaber as argued in reference to Claims 1 and 30 above. The same responses to the above claims apply here.

f. The Applicant argues against the Official Notices on page 7 and 8 of the previous office action, in particular to the Officially Noted fact that "viewing, clicking on, printing, playing, listening to, or downloading and storing the message" was well known types of interactions a user performs with information being displayed on the user's computer. However, the Applicant has not provided any substantial argument or facts on which if any of the above types of interactions are not well known. A general statement that the Applicant doesn't agree with the Officially Noted fact is not a traversal, but merely an opinion. As to providing evidence that a computer user could interact with information presented on his computer in one or more of the above manners, the Examiner invites the Applicant to look at the computer on his desk to determine if it has the normal input and output devices, such as a keyboard, a mouse or trackball, a display screen, speakers, printer, etc., which would be used for "viewing, clicking on, printing, playing, listening to, or downloading and storing messages".

g. The Applicant argues in reference to Claims 20 and 21 that the rejection is improper because it does not contain motivation. The Examiner first notes that these are improper dependent claims as noted above, since they fail to further limit their parent claim (Claim 13). As such, the rejection of Claim 13 applies to these two claims also. No additional motivation is required, since no additional steps are being performed.

### *Conclusion*

7.     Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.  Accordingly, **THIS ACTION IS MADE FINAL.**  See MPEP § 706.07(a).  Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action.  In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action.  In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (571) 272-6722.  The examiner can normally be reached Monday through Thursday from 5:30 a.m. to 3:30 p.m.
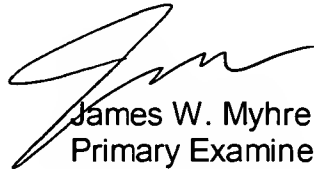
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (571) 272-6724.  The fax phone number for Formal or Official faxes to Technology Center 3600 is (571) 273-8300.  Draft or Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (571) 273-6722.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the Group Receptionist whose telephone number is

(571) 272-3600.

/JWM

October 5, 2005

James W. Myhre
Primary Examiner
Art Unit 3622